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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/009,118	12/06/2001	Hyuk-Jun Nam	0136/0K089US	8450

7590

12/16/2003

Darby & Darby
805 Third Avenue
New York, NY 10022

EXAMINER

PARKIN, JEFFREY S

ART UNIT	PAPER NUMBER
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1648

DATE MAILED: 12/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/009,118

Applicant(s)

NAM ET AL.

Examiner

Jeffrey S. Parkin, Ph.D.

Art Unit

1648

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Detailed Office Action***Status of the Claims***

1. Claims 1-20 are pending in the instant application. No preliminary amendments accompanied the filing.

35 U.S.C. § 120

2. If applicant desires priority under 35 U.S.C. § 120 based upon a previously filed copending application, specific reference to the earlier filed application must be made in the instant application. This should appear as the first sentence of the specification following the title, preferably as a separate paragraph. The status of non-provisional application(s) (whether patented or abandoned) should also be included. If a parent application has become a patent, the expression "now Patent No. _____" should follow the filing date of the parent application. If a parent application has become abandoned, the expression "now abandoned" should follow the filing date of the parent application. If applicant desires priority based upon a National Stage filing, this information should also be referenced in the first sentence of the specification (i.e., This application is a National Stage entry of International Application No. PCT/CCPY/NNNNN, filed , 199N).

35 U.S.C. § 119

3. Acknowledgment is made of applicant's claim for foreign priority based on application ROK 2000-0018489 filed on 08 April, 2000. It is noted, however, that applicant has not filed a certified copy of the application as required by 35 U.S.C. § 119(b).

Information Disclosure Statement

4. The information disclosure statement filed 06 December, 2001, has been placed in the application file and the information

referred to therein has been considered.

37 C.F.R. § 1.72

5. This application does not contain an abstract of the disclosure as required by 37 C.F.R. § 1.72(b). An abstract will be suggested by the Examiner when the application is allowed. Alternatively, applicants are directed toward § 608.01(b) of the M.P.E.P for guidance concerning the proper content of an abstract of the disclosure.

35 U.S.C. § 101

6. The following is a quotation of 35 U.S.C. § 101 which reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

7. Claim 20 is rejected under 35 U.S.C. § 101 because the claimed invention is directed toward non-statutory subject matter. The claims contain improper process language. Refer to M.P.E.P. § 2173.05(q). *Ex parte Dunki*, 153 U.S.P.Q. 678 (Bd. App. 1967). *Clinical Products Ltd. v. Brenner*, 255 F.Supp. 131, 149 U.S.P.Q. 475 (D.D.C. 1966).

35 U.S.C. § 103(a)

8. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5 Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

10 9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. § 1.56 to point out the inventor and
15 invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. § 103(c) and potential 35 U.S.C. § 102(f) or (g) prior art under 35 U.S.C. § 103(a).

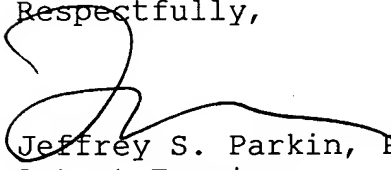
20 10. Claims 1-20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Bacharach and Goff (1998) in view of Strair et al. (1993). Bacharach and colleague disclose an assay for studying binding interactions between the HIV-1 NC protein and HIV-1 RNA encapsidation signal (HIV Ψ). The NC protein, target RNA, and
25 indicator gene (β -gal) were expressed from separate plasmids. Strair and associates provide a simple two-plasmid system for identifying antivirals, as well as, drug-resistant variants. Therefore, it would have been *prima facie* obvious to one having ordinary skill in the art at the time the invention was made to
30 modify the screening assay of Bacharach and Goff (1998) to include both the packaging signal and reporter gene on the same plasmid. This would provide a facile means for identifying antivirals. It should be noted that numerous HIV-1 isolates have been sequenced. Accordingly, the selection of any given packaging sequence is
35 simply a matter of routine experimentation. Moreover, the

identification of suitable expression vectors is also a matter of routine expression.

Correspondence

5 11. Correspondence related to this application may be submitted
to Group 1600 by facsimile transmission. The faxing of such papers
must conform with the notice published in the Official Gazette,
1096 OG 30 (November 15, 1989). Official communications should be
directed toward the following Group 1600 fax number: (703) 872-
10 9306. Any inquiry concerning this communication should be directed
to Jeffrey S. Parkin, Ph.D., whose telephone number is (703) 308-
2227. The examiner can normally be reached Monday through Thursday
from 8:30 AM to 6:00 PM. A message may be left on the examiner's
voice mail service. If attempts to reach the examiner are
15 unsuccessful, the examiner's supervisors, Laurie Scheiner or James
Housel, can be reached at (703) 308-1122 or (703) 308-4027,
respectively. Any inquiry of a general nature or relating to the
status of this application should be directed to the Group 1600
receptionist whose telephone number is (703) 308-0196.

Respectfully,


Jeffrey S. Parkin, Ph.D.
Patent Examiner
Art Unit 1648

12 December, 2003